

## REMARKS

Favorable reconsideration and allowance of the claims of the present application are respectfully requested.

Claims 1-9 and 12-18 are present in this application and have been subjected to restriction by the Examiner under 35 U.S.C. §121 (37 C.F.R. §1.142) as follows:

- I: Claims 1-9 and 12-18, drawn to compounds.
- II: Claim 18, drawn to a method of using compounds.

In support of the present Restriction Requirement, the Office Action has alleged that Groups I and II are related as product and process for use.

As indicated, and in order to be fully responsive to the Examiner's requirement for restriction, applicants provisionally elect, with traverse, to prosecute the subject matter of Group I, Claims 1-9 and 12-18, drawn to compounds. In regard to the species election, applicants hereby elect, with traverse, N-acetyl-2-amino-2-[4-(4-S-nitroso-mercapto-1-methylpiperidin)]acetic acid. Applicants respectfully submit that Claims 1-9 and 12-18 read on the elected species. Applicants hereby reserve their right to have other species considered upon allowance of a generic claim.

Applicants hereby reserve their right to file a divisional application(s) directed to the non-elected subject matter in this application.

However, pursuant to 37 C.F.R. §§1.111 and 1.143, applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof for the following reasons.

Applicants respectfully request that the Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141 and 1.142.

35 U.S.C. §121 provides that the Commissioner may restrict an application when two or more independent and distinct inventions are claimed in a single application (emphasis added). Similarly, 37 C.F.R. §1.141(a) permits restriction on condition that independent and distinct inventions are found within one application.

The United States Patent and Trademark Office has the burden of making a prima facie case that the subject matter is distinct and independent. The United States Patent and Trademark Office has not met this burden; it did not show that the various groups are distinct or independent. In fact, the Office Action did not even make any such allegation. For example, there is absolutely no indication in the Office Action that Groups I-II are independent. Thus, the Office Action has not shown that the claimed subject matter in the various groups are independent and distinct as required.

Moreover, applicants submit that there is an interdependence between each of the groups alleged to be patentably distinct.

MPEP §802.01 defines independent as follows:

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is they are unconnected in design, operation or effect...

Applicants respectfully submit that the subject matter in Groups I and II are connected in design, operation or effect and are thus not dependent. The subject matter of Group I is directed to compounds, while the subject matter of Group II is directed to a method of using same. Thus, Groups I and II are related and are not independent. They therefore have a disclosed relationship. Consequently, because the Office Action has not even alleged the statutory required "independence" of these groups and further because these groups of

claims are connected in design, operation and/or effect and are therefore not independent, the claims which the Office Action has grouped separately are not "independent and distinct" so as to justify the Restriction Requirement. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

Moreover, the United States Patent and Trademark Office has not complied with MPEP §808, which states

Every requirement to restrict has two reasons: (A) the reason as distinguished from the mere statement of conclusion why the invention as claimed are either independent or distinct and (B) the reason for insisting upon restriction therebetween as set forth in the following sections.

The United States Patent and Trademark Office failed to provide any reasons. It just gave a mere conclusion that the restriction requirement is improper. Thus, since the Office Action did not comply with this section, the Restriction Requirement is improper for still another reason and should be withdrawn.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein, so as to encourage applicants to provide a more detailed disclosure of all aspects of their invention. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts.

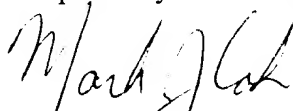
It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from

clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public's interest in the legitimacy of issued patents, applicant respectfully urges the Examiner not to require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

Hence, it is again respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,



Mark J. Cohen

Registration No. 32,211

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530  
(516) 742-4343  
HR/MJC:lf